

REMARKS

In light of the above amendments and following remarks, reconsideration and allowance of this application are respectfully requested.

I. STATUS OF THE CLAIMS AND FORMAL MATTERS

Claims 1-8 are pending in this application and are rejected in the Office Action. In this response, claims 1 and 5 have been amended and claims 4 and 8 have been cancelled. No new subject matter is added as a result of the amended claims.

It is submitted that these claims are patentably distinct from the prior art cited by the Examiner, and that these claims are in full compliance with the requirements of 35 U.S.C. §112. The remarks made herein are not made for the purpose of patentability within the meaning of 35 U.S.C. §§ 101, 102, 103 or 112, but rather the amendments and remarks made herein are simply for clarification and to round out the scope of protection to which Applicants are entitled.

II. THE REJECTIONS UNDER 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a)

In the Office Action, claims 1, 2, 5 and 6 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,089,708 to Ku ("Ku") and claims 3, 4, 7 and 8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ku. Although claims 4 and 8 have been cancelled, the elements associated with claims 4 and 8 have been added to amended independent claims 1 and 5 and therefore, the rejections will be addressed. The rejections are traversed for at least the following reasons.

The instant invention is directed to an auxiliary eyeglass unit that attaches to a primary eyeglass unit by means of a magnet. Independent claims 1 and 5 have been amended to include the following elements:

wherein said connecting member is shaped as an elongated rod, and has a horizontal middle rod portion, and two curved side

rod portions that are formed respectively and integrally with two opposite ends of said middle rod portion, said curved side rod portions abutting respectively against and being connected respectively and fixedly to outer peripheries of rear side surfaces of said auxiliary lenses, said eyeglass assembly further comprising two hinge units for connecting said curved side rod portions of said connecting member respectively and pivotally to said magnetic connector such that forward removal of said connecting member from said magnetic connector is prevented. (Emphasis added).

Ku is directed to an eyeglasses frame having auxiliary eyeglasses. Ku, however, does not disclose auxiliary eyeglasses comprising two hinge units for pivotally connecting the curved side rod portions of the connecting member to the magnetic connector. Instead, Ku discloses that the auxiliary eyeglasses 2 have a single connecting rod member 22. *See* col. 2, lines 42-43. The specification further states, “[in] combination, the connecting member 3 is fitted to the main frame 1 from the rear connecting plates 31. The auxiliary eyeglasses 2 is pivoted on the connecting member 3....” Col. 2, lines 60-63. Therefore, in Ku, the auxiliary eyeglasses pivot and connect to the magnetic connecting member 3 at only one point. Hence, the instant invention differs from Ku in that the auxiliary glasses connect to the magnetic connector with hinge units at two points, which results in two pivot points.

Moreover, the two hinge units of the instant invention result in a more stable connection between the auxiliary eyeglasses and the primary eyeglasses because the auxiliary eyeglasses pivot around two points instead of one. Furthermore, in the instant invention, the auxiliary eyeglass unit 20 attaches to the magnetic connector 5 by interposing the two integral sleeves 51 of the magnetic connector 5 with the two notches 43 in the hinge units 4 of the auxiliary eyeglass unit 20, and fixedly connecting the sleeves 51 and the notches 43 to each other with pivot pins 44. Page 5, lines 4-15. This type of connection prevents the unintentional forward removal of the auxiliary glasses that can occur in Ku since in Ku, the auxiliary glasses 2 attach to the

magnetic connecting member 3 only by inserting the intermediate portion 221 of the connecting rod member 22 into the holding room 322 of the magnetic connecting member 3. *See* col. 2, lines 42-59. Therefore, since the connecting rod member 22 basically “snaps” into the holding room 322, the auxiliary eyeglasses of Ku are more likely to become accidentally disengaged from the primary glasses and forwardly removed.

In addition, the connecting rod member 22 and front connecting part 32 of the connecting member 3 of Ku are disposed above and spaced apart from the bridge 12 of the main frame 1. The pronounced placement of the connecting member 3 is not aesthetically pleasing. The design of the instant invention overcomes the poor aesthetics of Ku by using a small U-shaped plate 52 to secure the auxiliary eyeglass unit 2 to the bridge 12 of the primary eyeglass unit 10 in conjunction with two small hinge units 4 and integral sleeves 51.

Regarding claims 3 and 7, the Examiner seems to take Official Notice that resin is a commonly known material for use in auxiliary lenses. Applicant respectfully disagrees and requests that references be provided to support the Examiner’s claim. It is error for the Examiner to merely assert that a claimed element not found in the cited art is well known in the art if no reasons or authorities are relied upon for support. With regard to the use of Official Notice, reference is made to *In re Pardo and Landau*, 214 U.S.P.Q. 673 (C.C.P.A. 1982) in which the court states:

Assertions of technical facts in areas of esoteric technology must always be supported by citation to some reference work recognized as standard in the pertinent art and the applicant given, in the Patent Office, the opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference.

Id. at 677 (citing *In re Ahlert*, 165 U.S.P.Q. 418, 420-21 (C.C.P.A. 1970)). The M.P.E.P. also states, “it is never appropriate to rely solely on ‘common knowledge ’ in the art without

evidentiary support in the record, as the principal evidence upon which the objection was based.” M.P.E.P § 2144.03(a) (quoting *In re Zurko*, 59 U.S.P.Q.2d 1693, 1697 (Fed. Cir. 2001). In view of *In re Pardo and Landau*, *In re Ahlert* and the M.P.E.P., it is improper for the Examiner to fail to cite a reference that specifically describes the invention as recited in the claims.

Lastly, with respect to claims 4 and 8, the Examiner states that although Ku does not teach the exact shape of the curved side rod portion abutting against the outer periphery of the auxiliary lens as claimed in the instant invention, it would have been obvious to modify Ku to include curved side rod portions having the same shape as claimed by the applicant. In support, the Examiner further states, “shape, size [and] dimension differences are considered obvious choices and are not patentable unless unexpected results are obtained from these changes” and that “[s]uch a modification would have no functional differences from the Ku reference.” We respectfully disagree.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or to combine reference teachings either in the references themselves or in the general knowledge available to one of ordinary skill in the art; second, there must be a reasonable expectation of success; third, the prior art reference or references must teach or suggest all the claim limitations. M.P.E.P. § 2143. It is, however, impermissible for the Examiner to use hindsight based on an Applicant’s disclosure to determine that an Applicant’s invention is obvious in view of the cited art. M.P.E.P. § 2142. The motivation or teaching to make the claimed combination by modifying or combining prior art references must be found in the prior art and not in the Applicant’s disclosure. *In re Vaeck*, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Therefore, since modifying the shape for the periphery of the auxiliary lenses to have curved side portions in order to facilitate a

more stable attachment configuration in the form of two hinges is not suggested by Ku, the modification is not obvious.

Moreover, the Examiner's argument that the curved side portions of the instant invention are just a change in shape and is therefore obvious, fails as well. A change in shape will not be found obvious if it can be shown that the particular configuration or shape was significant. *See In re Dailey*, 149 U.S.P.Q. 47 (C.C.P.A. 1966) (holding that the configuration of a claimed disposable nursing container was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed container was significant). As discussed above, the side rod portions of the instant invention are curved in order to provide two connecting points, in the form of hinges, between the primary lenses and the auxiliary eyeglass unit. This is significant because, as previously discussed, the two hinges and hence two pivot points of the instant invention provide for a more stable connection over the one connecting point in Ku. Therefore, since the curved side rod portions 32 of the auxiliary eyeglass unit in the instant application are significant and are functionally different, they are not obvious in view of Ku.

For at least the foregoing reasons, it is respectfully submitted that revised independent claims 1 and 5 patentably distinguish over Ku and are therefore allowable. Further, claims 2 and 3, which depend from claim 1 and claims 6 and 7, which depend from claim 5 are allowable therewith.

In the event, that the Examiner disagrees with any of the foregoing comments concerning the disclosures in the cited prior art, it is requested that the Examiner indicate where, in the reference or references, there is the basis for a contrary view.

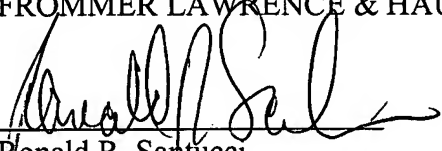
CONCLUSION

In view of the foregoing, it is believed that all of the claims in this application are patentable over the prior art, and an early and favorable consideration thereof is solicited.

Please charge any fees incurred by reason of this response and not paid herewith to Deposit Account No. 50-0320.

Respectfully submitted,
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